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2700 CAREW TOWER
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CINCINNATI OH 45202

MAILED
SEP 21 2010
OFFICE OF PETITIONS

In re Patent No. 6,603,052 :
Issue Date: August 5, 2003 :
Application No. 09/865,822 : **DECISION ON PETITION**
Filed: May 25, 2001 : **UNDER 37 CFR 1.378(b)**
For: TRIL-05/119 :

This is a decision on the petition under 37 CFR 1.378(b), filed June 29, 2010, to accept an unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). **Any such petition for reconsideration must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f).** The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued August 5, 2003. The 3.5 year maintenance fee could have been paid from August 5, 2006, through February 5, 2007, or with a surcharge during the period from February 6, 2007 through August 5, 2007. Accordingly, the patent expired February 5, 2007, for failure to timely submit the second maintenance fee. Accordingly, the patent expired August 5, 2007 for failure to timely submit the 3.5-year maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

This petition lacks item requirement (1) set forth above.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". 35 U.S.C. § 41(c)(1).

The patentees of record are joint inventors John E. Davis and Timothy P. Klonne. The joint inventors were partners in TollamCo, Corp. Mr. Davis is represented by counsel of the law firm of Wood, Herron & Evans, LLP (WHE).

The petition and supporting documents assert that Mr. Davis suffered a stroke around the time that the patent issued and that Mr. Davis still suffers from the effects of the stroke, including memory issues. The petition and supporting documents assert that Mr. Davis was incapacitated from the stroke from May 7, 2003 to October 2003.

The petition and supporting documents indicate that the patent was supposed to be assigned to a corporate entity, but this never occurred.

The petition and supporting documents further assert that on May 1, 2003, TollamCo, Corp closed and that the corporation was liquidated from May, 2003 to November 2003. It was agreed that Mr. Davis would maintain the corporate record for TollamCo, Corp. The corporate records are said to have been housed by Blue Horizon, Inc., a company owned by Mr. Davis' daughter. On August 8, 2003, WHE forwarded the Letters Patent to Mr. Davis at the address of his daughter. Mr. Davis' daughter was assisting him in his recovery. The letter accompanying the Letters Patent provided information concerning future maintenance fees. Thereafter, the Letters Patent was housed in a drawer at Blue Horizon, Inc. on behalf of Mr. Davis, who was not working at that time. Mr. Davis does not recall receiving or reading the original patent. Eventually, TollamCo, Corp. files were moved from Blue Horizon, Inc. to Newport Converting, another corporation owned by Mr. Davis' daughter.

Petitioner further indicates that as TollamCo, Corp. had gone out of business, there was no docketing system in place at TollamCo, Corp. for the patent. Petitioner indicates Mr. Davis did not receive or file the patent. Petitioner asserts that due to Mr. Davis' condition, he did not note the maintenance fee due dates or docket the due dates for payment.

The petition and supporting documents further assert that Mr. Davis suffers from heart failure, having undergone heart surgery on January 7, 2007, December 7, 2007, and October 20, 2008. There are further assertions that Mr. Davis remains on heavy medications and on much a restricted physical activity level.

Reminder letters sent from WHE to Mr. Davis care of TollamCo, Corp. were received due to the closure of the corporation.

Petitioner asserts that on September 22, 2009, Mr. Davis discovered the Letters Patent while going through old files. On September 22, 2009, Mr. Davis contacted his legal counsel at WHE to seek information regarding the maintenance fee for the instant patent. Mr. Davis did not pay the maintenance fee. WHE advised Mr. Davis that the maintenance fee had not been paid and that the patent was expired for non-payment of the maintenance fee. Mr. Davis indicated he wanted to revive the patent and pay the maintenance fee due. On September 25, 2009, WHE advised Mr. Davis that he was going to have to investigate the facts regarding the owner of the Patent, the actions of the owner, and provide information surrounding the patent, the

maintenance fees, and other issues in order to determine that the delay of the payment was unavoidable.

Upon investigation, Mr. Davis was unable to locate or reach joint inventor Mr. Klonne. The petition and supporting documentation assert that Mr. Klonne "verbally assigned" the patent to Mr. Davis pursuant to a telephone call. The details of this telephone call are said to be documented in a note written by Mr. Davis and dated August 14, 2003, copy of which has been provided.

The petition and supporting documents assert that as a result of the Mr. Davis' ongoing medical problems, the investigation into the failure to pay the maintenance fee and the delay in filing the petition were arduous and drawn out, but that the investigation was completed May 6, 2010.

Petitioner seemingly attributes the failure to timely remit the 3.5 year maintenance fee to Mr. Davis' ongoing health problems related to a stroke and heart failure.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, i.e. "unavoidable delay". Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard in determining if the delay in responding to an Office action was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a showing that any steps were emplaced by petitioner or anyone else. In the absence of a showing that petitioner or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most

important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra. Put otherwise, the issues of Mr. Davis' personal health are immaterial in the absence of a showing that the problems he attributes to his personal health, and not the lack of any steps in place to pay the fee, caused or contributed to the delay.

As to the physical condition described by petitioner, petitioner should note that under the circumstances of this case, he will have to provide documents from licensed health care providers, demonstrating the nature and extent of petitioner's incapacitation, in such a manner that petitioner was, from the date of expiry until the filing of the instant petition, "unavoidably" prevented from taking any earlier action with respect to this patent. Additionally, petitioner must state how he managed to conduct his daily personal and business affairs, including scheduling and settlement of short and long term debts and business obligations, bills, rent or mortgage payments, income taxes etc., during the time in question. Petitioner must demonstrate that his physical condition was such as to cause the payment of the maintenance fee to have been unavoidably delayed.

As Mr. Davis acknowledges that there was no docketing system in place to track the maintenance fee due date for the patent, unavoidable delay has not been shown. Mr. Davis' failure to maintain communication with his legal representation further cannot be found to have been unavoidable.

As the Office must look to the party responsible for paying the maintenance fee, the actions and inactions of both owners of record are material. Petitioner asserts that Mr. Davis is the sole owner of the patent by virtue of a verbal assignment between Mr. Davis and Mr. Klonne, details of which are set forth in a note written by Mr. Davis dated August 14, 2003.

"Assignment," in general, is the act of transferring to another the ownership of one's property, i.e., the interest and rights to the property. In 37 CFR 3.1, assignment of patent rights is defined as "a transfer by a party of all or part of its right, title and interest in a patent or patent application...." An assignment of a patent, or patent application, is the transfer to another of a party's entire ownership interest or a percentage of that party's ownership interest in the patent or application. In order for an assignment to take place, the transfer to another must include the entirety of the bundle of rights that is associated with the ownership interest, i.e., all of the bundle of rights that are inherent in the right, title and interest in the patent or patent application. See, MPEP 301. Furthermore, applications for patent, patents, or any interest therein, shall be assignable in law by an instrument **in writing**. (Emphasis added.) See, 35 USC 261.

Accordingly, it must be found that joint inventor Klonne remains an owner of the patent. Accordingly, Mr. Klonne's actions remain relevant to the failure to timely pay the maintenance fee. Petitioner asserts Mr. Klonne cannot be located. Nonetheless, absence a showing concerning the actions of Mr. Klonne to track, or engage someone to track the maintenance fee, Mr. Klonne's failure to timely remit the maintenance fee cannot be found to have been unavoidable.

Any renewed petition must establish that the entire period of delay from the time that the maintenance fee was due until the time of the filing of a grantable petition has been unavoidable. Petitioner is reminded that any renewed petition should entail an exhaustive effort to establish that the failure to timely pay the maintenance fee was unavoidable as after reconsideration pursuant to 37 CFR 1.378(e), no further reconsideration regarding unavoidable delay will be undertaken.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown
Petitions Attorney
Office of Petitions

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF
MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(b))**Docket Number (Optional)
TRIL-05Mail to: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450
Fax: (571) 273-8300NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at
(571) 272-3282.Patent Number: 6,603,052Application Number: 09/865,822Issue Date: 08/05/2003Filing Date: 05/25/2001

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number (or reissue patent number, if a reissue) and (2) the application number of the actual U.S. application (or reissue application) leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

Also complete the following information, if applicable:

The above-identified patent:

☐ is a reissue of original Patent No. _____ original issue date _____;
original application number _____
original filing date _____☐ resulted from the entry into the U.S. under 35 U.S.C. 371 of international application
_____ filed on _____**CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is

(1) being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 OR

(2) transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

Date_____
Signature_____
Typed or printed name of person signing Certificate

09/21/2010 CKHLOK 00000002 233000 6603052

[Page 1 of 4]

01 FC:1557
02 FC:2551700.00 DA
490.00 DA

This collection of information is required by 37 CFR 1.378(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

1. SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27

2. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

3. MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition, unless it was paid earlier.

NOT Small Entity			Small Entity		
Amount	Fee	(Code)	Amount	Fee	(Code)
<input type="checkbox"/> \$ _____	3 ½ yr fee	(1551)	<input type="checkbox"/> \$ <u>555.00</u>	3 ½ yr fee	(2551)
<input type="checkbox"/> \$ _____	7 ½ yr fee	(1552)	<input type="checkbox"/> \$ _____	7 ½ yr fee	(2552)
<input type="checkbox"/> \$ _____	11 ½ yr fee	(1553)	<input type="checkbox"/> \$ _____	11 ½ yr fee	(2553)

MAINTENANCE FEE BEING SUBMITTED \$ 555.00

4. SURCHARGE

The surcharge required by 37 CFR 1.20(i)(1) of \$ 700.00 (Fee Code 1557) must be paid as a condition of accepting unavoidably delayed payment of the maintenance fee.

SURCHARGE FEE BEING SUBMITTED \$ 700.00

5. MANNER OF PAYMENT

- ☐ Enclosed is a check for the sum of \$ _____
- ☒ Please charge Deposit Account No. 233000 the sum of \$ 1,255.00
- ☐ Payment by credit card. Form PTO-2038 is attached.

6. AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

☒ The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account No. 233000

7. OVERPAYMENT

As to any overpayment made, please

☒ Credit to Deposit Account No. 233000

OR

☐ Send refund check

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

8. SHOWING

The enclosed statement will show that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that this petition is being filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The statement must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which the patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

9. PETITIONER(S) REQUESTS THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED.

/Kurt A. Summe/

Signature(s) of Petitioner(s)

06/29/2010

Date

Kurt A. Summe, Attorney of Record

Typed or printed name(s)

36023

Registration Number, if applicable

Wood, Herron & Evans, LLP, 441 Vine Street #2700

Address

513-241-2324

Telephone Number

Cincinnati, OH 45202

Address

ENCLOSURES:

- ☒ Maintenance Fee Payment
- ☒ Statement why maintenance fee was not paid timely
- ☒ Surcharge under 37 CFR 1.20(i)(1) (fee for filing the maintenance fee petition)
- ☒ Other:

Declarations of John E. Davis, Gretchen J. Franck, and Kurt A. Summe in Support of Statement why maintenance fee was not paid timely.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

/Kurt A. Summe/

Signature

06/29/2010

Date

Kurt A. Summe, Attorney of Record

Type or printed name

36023

Registration Number, if applicable

STATEMENT

(In the space below, please provide the showing of unavoidable delay recited in paragraph 8 above.)

See Attached Filed Document.

(Please attach additional sheets if additional space is needed)